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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,866	03/29/2004	Peter Gallina	P24995	9867
7055	7590	10/24/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LAZORCIK, JASON L	
			ART UNIT	PAPER NUMBER

1731

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,866

Applicant(s)

GALLINA ET AL.

Examiner

Jason L. Lazorcik

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/176,962.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of prior-filed nonprovisional application No. 09/512,304, filed February 24, 2000 and application 09/176,962, filed October 22, 1998 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. The applicant is directed to two separate breaks in continuity between the present application and prior filed applications to which the current claim of continuity is directed. Specifically, a first break in application continuity exists between the date of abandonment of application 09/176,962 on 12/28/1999 and the filing date of application 09/512,304 on 02/24/2000, and a second break in application continuity exists between the date of abandonment of application 09/512,304 on 03/02/2004 and the filing date of the present application 10/810,866 on 03/29/2004.

Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an applications filed in Germany on 10/24/1997, 05/06/1998, 05/08/1998, and 05/27/1998. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since copendency with application United States 09/176,962 has not been established as set forth above, and the immediate United States application was filed more than twelve months after the foreign filing dates.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11, 13, 15-18, and 20-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cedra et. al (DE 297 23 289 U1).

Precedent for the basis of Claims 1-5 can be found in the prior art on page 3, lines 1-24

Precedent for claim 11 is set forth on pages 5 line 29 through page 6, line 5

Precedent for claim 13 can be found on page 4, lines 16-24

Claims 15 through 18 are clearly set forth in the prior art on page 6, lines 16-23

Precedent for claims 20 through 23 can be found in the prior art on page 3, lines 1-24 and page 4, lines 26- page5, line 3

Precedent for claim 24 can be found in the prior art page 6, lines 16-23 and on page 4, lines 26- page5, line 3.

The above application of the prior art under 35 USC 102(b) to the immediate claims has been set forth in order to assist the applicant in determining the relevant sections of the prior art document in the context of the applicants claimed invention. Due to the applicants assertion of foreign priority under 35 USC 119 over the prior art and the fact that the applicant has failed to successfully establish a claim thereto for the reasons set forth above, the immediate reference is treated as valid prior art for the present application. Therefore, the burden is shifted to the applicant to demonstrate that the claimed invention is neither explicitly nor implicitly disclosed in the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-10, 12, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cedra et. al. (DE 297 23 289 U1) as applied to Claim 1 above under 35 USC 102(b) and in further view of Steiner et. al. (DE 198 23 739 A1).

'289 fails to explicitly indicate the location of the guiding or the applying of the coating medium in the context of the wider manufacturing process. The '739 reference sets forth (column 3, line 28 through column 4, line 54, and Figures 1-4) a manufacture process incorporating the teachings of the '289 reference and disclosing locations for the guiding and applying processes. It would have been obvious to one of ordinary skill in the art to incorporate the coating process disclosed in '289 into a larger manufacture process as described in '739 in order to produce a finished paper or cardboard product.

In similar fashion to the discussion for the use of applicants foreign priority documents in the rejection under 35 USC 102(b) above, the rejection under 35 USC 103(a) of claims 6-10, 12, 14, and 19 has been set forth in order to assist the applicant in determining the relevant sections of the prior art documents in the context of the applicants claimed invention. Given the applicants assertion of foreign priority under 35 USC 119 over the prior art it is understood that said foreign prior art documents collectively provide every limitation for the claimed invention in the US application. Since the applicant has failed to successfully establish a valid claim to foreign priority for the reasons set forth above, the immediate references are treated as valid prior art for the present application. Therefore, the burden is shifted to the applicant to demonstrate that the claimed invention is neither explicitly nor implicitly disclosed in the combined teachings of Cedra and Steiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DE 197 47 091A1 provides pertinent information relevant to the claimed coating application process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JLL


ERIC HUG
PRIMARY EXAMINER